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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/641,149	08/17/2000	Mark Gary Weinberg	CL1375 US NA CIP	4752

23906 7590 06/27/2003

E I DU PONT DE NEMOURS AND COMPANY
LEGAL PATENT RECORDS CENTER
BARLEY MILL PLAZA 25/1128
4417 LANCASTER PIKE
WILMINGTON, DE 19805

EXAMINER

SHOSHO, CALLIE E

ART UNIT PAPER NUMBER

1714

DATE MAILED: 06/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/641,149

Applicant(s)

WEINBERG ET AL.

Examiner

Callie E. Shosho

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 15, 31 and 32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 15, 31 and 32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. All outstanding rejections are overcome by applicants' amendment filed 4/16/03.

The following rejection is non-final in light of the new grounds of rejection as set forth below.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-9 and 15 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 and 12 of copending Application No. 10/343,274. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following explanation.

The present claims and the copending claims of 10/343,274 overlap to a significant extent. Copending 10/343,274 discloses composition comprising polyoxymethylene and up to 10 mol% repeat units comprising oxyalkylene radicals having adjacent methylene groups, about 1-30 vol.% or 10-20 vol.% mineral filler having aspect ratio of 5 or less, the filler having average equivalent spherical diameter in the range of about 0.1 to less than about 3.5 micrometers or about 0.5 to about 2 micrometers, and a saturated carboxylic acid, salt thereof, or mixture thereof at a concentration of at least about 0.5% by weight or 0.5-4% by weight of the mineral filler wherein the saturated carboxylic acid is a saturated fatty acid, salt thereof, or a mixture thereof such as stearic acid and the filler is calcium carbonate. There is also disclosed a shaped article comprising the above composition.

The only difference between copending 10/343,374 and the present claimed invention is that the present claims require that the composition comprises polyacetal polymer comprising polyoxymethylene while the present claims require that the composition comprises at least 80 mol% of oxymethylene repeat units.

However, given that the present claims encompass composition wherein the polymer comprises 100 mol% oxymethylene repeats units, i.e. polyoxymethylene homopolymer, and given that the disclosure in the copending claims of polyoxymethylene encompasses polyoxymethylene homopolymer, i.e. using 0 mol% repeat units comprising oxyalkylene radicals

having adjacent methylene groups, it is clear that the disclosure of polyoxymethylene in the copending claims falls within the scope of the polymer disclosed in the present claims and thus, one of ordinary skill in the art would arrive at the present claims from the copending ones.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. Claims 1 and 31-32 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 10 of copending Application No. 10/343,274. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following explanation.

The present claims and the copending claims of 10/343,274 overlap to a significant extent. Copending 10/343,274 discloses composition comprising polyoxymethylene and up to 10 mol% repeat units comprising oxyalkylene radicals having adjacent methylene groups such as ethylene oxide repeat units, about 1-30 vol.% mineral filler having aspect ratio of 5 or less, the filler having average equivalent spherical diameter in the range of about 0.1 to less than about 3.5 micrometers, and a saturated carboxylic acid, salt thereof, or mixture thereof at a concentration of at least about 0.5% by weight.

The only difference between copending 10/343,274 and the present claimed invention is that the present claims disclose saturated organic acid, salt thereof, or mixture thereof while the copending claims disclose saturated carboxylic acid, salt thereof, or mixture thereof.

However, one of ordinary skill in the art would have recognized that the carboxylic acid in the copending claims is but one obvious variant of the broadly disclosed organic acid in the

present claims. It is within the skill level of one of ordinary skill in the art to recognize that the disclosure of carboxylic acid in the copending claims is one specific type of organic acid presently claimed and thus falls within the scope of the present claims. Thus, one of ordinary skill in the art would have arrived at the present claims from the copending claims ones.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 1-9 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 01170641 in view of Moss (U.S. 4,698,378).

Pending translation, it is noted that JP 01170641 discloses composition comprising polyacetal resin, 1-100 parts filler having average particle size of 0.05-10 micrometers, which is oxide, hydroxide, carbonate, silicate, sulfate of group II or group III metal such as calcium carbonate, and 0.5-10% C₁₂-C₃₀ fatty acid or salt thereof. The composition is used for interior of cars, i.e. shaped articles.

The difference between JP 01170641 and the present claimed invention is (a) aspect ratio of calcium carbonate filler and (b) volume % filler.

With respect to difference (a), Moss, which is drawn to resin composition, disclose use of calcium carbonate filler with aspect ratio less than 2 in order to impart suitable reinforcing effects to the composition (col. 5, lines 21-23).

In light of the above, it therefore would have been obvious to one of ordinary skill in the art to use calcium carbonate with aspect ratio less than 2 in JP 01170641 in order to produce composition with good reinforcement properties, and thereby arrive at the claimed invention.

With respect to difference (b), the present claims require about 1-30% by volume filler while JP 01170641 discloses the amount of filler in parts by weight not volume %.

However, given that broad range of filler disclosed by JP 01170641, i.e. 1-100 parts, it would have been natural for one of ordinary skill in the art to infer, absent evidence to the contrary, that this broad amount of mineral filler would overlap the presently claimed amount in volume %, and thus, one of ordinary skill in the art would have arrived at the claimed invention.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 703-305-0208. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

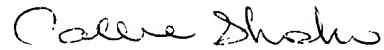
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Callie E. Shosho
Primary Examiner
Art Unit 1714

CS
June 24, 2003